UNITED STATES PATENT AND TRADEMARK OFFICE

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09/966,738	09/28/2001	Michael Soemo	2001P18038US	3567

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EXAMINER
CALDWELL, ANDREW T

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>29 March 2007</u>.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-13,15-39 and 47-53* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-13,15-39 and 47-53* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>27 October 2006</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20061019</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

1

2

3   *Specification*

4   The specification is objected to under 37 CFR 1.52(a)(1)(v) because, at pages 8-

5   9, the text labeling the columns of the table is shaded. Such text is not easily subject to

6   optical character recognition as per the rule.

7

8   *Claim Rejections - 35 USC § 112*

9   The following is a quotation of the first paragraph of 35 U.S.C. 112:

10   The specification shall contain a written description of the invention, and of the manner and process of
11   making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
12   art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
13   set forth the best mode contemplated by the inventor of carrying out his invention.
14
15   Claims 1-13, 15-39, and 47-53 are rejected under 35 U.S.C. 112, first paragraph,

16   because the specification, while being enabling for using the protocol in a LonTalk®

17   environment, does not reasonably provide enablement for implementing the invention

18   using another building automation and control network, such as a BACnet environment.

19   The amount of direction provided by the Applicants as to how implement their

20   invention using a protocol other than LonTalk® is negligible. On page 8 lines 11-16 of

21   the specification, the Applicants describe how their proprietary protocol is embedded in

22   the explicit messages fields of LonTalk® messages. The Examiner fails to see where in

23   the specification the Applicants have described how to implement their invention using

24   any protocol other than LonTalk®.

1   As to the existence of a working example, the Applicants have provided no

2   working example other than in the context of a LonTalk® environment. Although the

3   Applicants have raised BACnet as an alternative building automation and control

4   network (p. 2 lines 12-16), the remainder of the specification does not provide working

5   examples using protocols other than LonTalk®.

6   As to the state of the prior art, two references, although they are not prior art, are

7   particularly relevant. Swan describes how LonTalk®'s standard network variable types

8   are "quite unlike" BACnet objects (p. 1). Swan describes how the means and messages

9   by which LonTalk® standard network variable types are read and written are "quite

10   unlike" BACnet services (p. 1). The BACnet FAQ describes how the BACnet and

11   Echelon (i.e., LonTalk®) language are fundamentally different and devices using one of

12   the languages can never interoperate directly with devices using the other (p. 3 "You

13   mentioned that BACnet can use LonTalk®"). No evidence suggests that these

14   fundamental differences between the two protocols have not always existed. It is

15   therefore reasonable to infer that the state of the art at the time Swan and the BACnet

16   FAQ were written existed at the time the invention was made. The state of the prior art

17   would therefore suggest was such that a person of ordinary skill in the art would have

18   been unable to make and use the claimed invention using any building automation and

19   control protocol other than LonTalk®.

20   As to the breadth of the claims, they are written using generic terminology and

21   are not limited to the LonTalk® protocol.

1   As to the level of predictability in the art, it would suggest that the claimed

2   invention is enabled since this art is predictable.

3   In the response filed on 10/27/06, the applicants assert that incorporation of the

4   present invention in a predictable data transmission protocol would be within the skill of

5   one of ordinary skill in the art. If this statement is to be considered evidence, it has

6   been considered but is given little weight. Attorney argument cannot take the place of

7   evidence. See MPEP 2145.

8   The first four factors listed above weigh against a conclusion that the claimed

9   invention is enabled throughout its entire scope. The fifth factor would weigh in favor of

10 a conclusion that the claimed invention is enabled throughout its entire scope.   The

11 final factor is not probative since it is not evidence. 333After weighing the evidence, the

12 Examiner concludes that the state of the prior art is particularly important. When a

13 reference describes how fundamental differences exist between the two networks

14 disclosed in the specification as possible embodiments of the "generic" protocol of the

15 claims, the Examiner fails to see how the entire scope of the claim is enabled.

16

17   *Claim Rejections - 35 USC § 102*

18   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

19 form the basis for the rejections under this section made in this Office action:

20   A person shall be entitled to a patent unless –

21   (e) the invention was described in (1) an application for patent, published under section 122(b), by
22   another filed in the United States before the invention by the applicant for patent or (2) a patent
23   granted on an application for patent by another filed in the United States before the invention by the
24   applicant for patent, except that an international application filed under the treaty defined in section
25   351(a) shall have the effects for purposes of this subsection of an application filed in the United States

1   only if the international application designated the United States and was published under Article 21(2)
2   of such treaty in the English language.
3
4   Claims 1-5,8,10-13,15-16, 18-22, 25, 27-34, 36-39, and 47-51 are rejected under

5   35 U.S.C. 102(e) as being anticipated by Hite et al., U.S. Patent No. 6,763,040.

6   Regarding claims 1 and 47, they are rejected for the reasons given in the final Office

7   action mailed on August 9, 2005. Regarding claims 1-5,8,10-13,15-16, 18-22, 25, 27-

8   34, 36-39, and 47-53, they are rejected for the reasons given in the non-final Office

9   action mailed on January 14, 2005. Regarding claims 48-51, the limitations introduced

10 in these dependent claims are identical to those introduced in dependent claims 2-5.

11 Since the reasons for rejection given for claims 2-5 apply equally to claims 48-51, those

12 reasons will not be repeated.

13

14   *Claim Rejections - 35 USC § 103*

15   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

16 obviousness rejections set forth in this Office action:

17   (a) A patent may not be obtained though the invention is not identically disclosed or described as set
18   forth in section 102 of this title, if the differences between the subject matter sought to be patented and
19   the prior art are such that the subject matter as a whole would have been obvious at the time the
20   invention was made to a person having ordinary skill in the art to which said subject matter pertains.
21   Patentability shall not be negatived by the manner in which the invention was made.
22
23   This application currently names joint inventors. In considering patentability of

24 the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

25 the various claims was commonly owned at the time any inventions covered therein

26 were made absent any evidence to the contrary. Applicant is advised of the obligation

27 under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

28 not commonly owned at the time a later invention was made in order for the examiner to

1   consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

2   prior art under 35 U.S.C. 103(a).

3

4   Claims 9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

5   Hite for the reasons given in the non-final Office action mailed on January 14, 2005.

6

7   Claims 6-7 and 52-53 are rejected under 35 U.S.C. 103(a) as being unpatentable

8   over Hite in view of Nason et al., U.S. Patent App. Pub. 2002/0174240. As to claims 6-

9   7, they are rejected for the reasons given in the non-final Office action mailed on

10 January 14, 2005. Regarding claims 52-53, the limitations introduced in these

11 dependent claims are identical to those introduced in dependent claims 6-7. Since the

12 reasons for rejection given for claims 6-7 apply equally to claims 52-53, those reasons

13 will not be repeated.

14

15   Claims 23-24, 26, and 35 are rejected under 35 U.S.C. 103(a) as being

16 unpatentable over Hite in view of Albert et al., U.S. Patent No. 6,775,692, for the

17 reasons given in the non-final Office action mailed on January 14, 2005.

18

19   Claims 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhodes

20 et al., U.S. Patent No. 6,073,110, in view of Hite et al., U.S. Patent No. 6,763,040, and

21 the Admitted Prior Art.

22

1   Regarding claim 1, the preamble has been given patentable weight since the

2   claim body refers back to the preamble. See "the application controller and "the

3   applications" at lines 5-6. Rhodes teaches the invention substantially as claimed by

4   disclosing a communication protocol for use in a system controller that includes an

5   application controller (Fig. 1 elem. 20 control node) and a plurality of applications (Fig. 1

6   elems. 14 including applications 30) for controlling a plurality of device controllers (Fig. 2

7   elems. 24) on a control network (Fig. 1 elem. 22) using data relating to system points

8   (Fig. 2 Zone data) that correspond to data variables in a data network. Rhodes teaches

9   a plurality of predefined messages transmitted between the application controller and

10   the applications for instructing the application controller to perform a function relating to

11   a select system point and for reporting to the applications in response to said instruction

12   (col. 5 lines 29-51).

13   Rhodes does not teach a protocol wherein said communications protocol is a

14   proprietary protocol; said plurality of messages include a discover message transmitted

15   from the application to the application controller to determine whether the select system

16   point is stored in a database of the application controller; a message identification field

17   for identifying a select message from said plurality of messages; and a protocol

18   identification field for identifying said select message as being transmitted via said

19   proprietary protocol.

20   As to the limitation of a proprietary protocol, Hite teaches a proprietary protocol

21   per the admission in the first complete paragraph on page 6 of the defective Appeal

22   Brief filed on January 12, 2006. It would have been obvious to one of ordinary skill in

1   the art at the time the invention was made to modify Rhodes, which is silent as to

2   whether the protocol being used is proprietary or not, to use a proprietary protocol as

3   taught by Hite. The Applicants' specification states that, in this art, proprietary protocols

4   were the norm until recently (i.e., at the time the application was filed) and that use of

5   nonproprietary protocols is increasing. A person of ordinary skill in the art at the time

6   the invention was made would have known what the applicants admitted at page 2 lines

7   8-16. A person of ordinary skill in the art at the time the invention was made would

8   therefore have reasonably inferred, based on the state of the art, that Rhodes, which

9   was filed almost four years before this application, would use a proprietary protocol. It

10 would therefore have been obvious to one of ordinary skill in the art at the time the

11 invention was made to modify Rhodes to use a proprietary protocol as taught by Hite

12 based on logical reasoning from the APA.

13   As to the limitations of the protocol including a message identification field for

14 identifying a select message from said plurality of messages and a protocol

15 identification field for identifying said select message as being transmitted via said

16 proprietary protocol, Rhodes is silent as to the details of the protocol being used. Hite,

17 on the other hand, teaches these features (Fig. 11 elems. 670 and 690). It would have

18 been obvious to one of ordinary skill in the art at the time the invention was made to

19 modify the protocol of Rhodes to use a protocol field identifying the protocol and a

20 message field identifying a message as taught by Hite. This modification would have

21 been obvious because identifying the protocol would allow multiple protocols to be

1   supported and identifying the message would allow multiple messages to be supported,

2   thus making the system expandable.

3   As to the limitation of the plurality of messages include a discover message

4   transmitted from the application to the application controller to determine whether the

5   select system point is stored in a database of the application controller, Hite teaches a

6   discover message as claimed (Col. 33 lines 11-24). It would have been obvious to one

7   of ordinary skill in the art at the time the invention was made combine Hite's teaching

8   regarding retrieving a list of online devices with the system of Rhodes by having the

9   applications query the control node to determine which controlled devices are actually

10 online. This combination would have been obvious because it would allow the system

11 of Rhodes to determine which devices are online (Hite col. 33 lines 11-24).

12

13   ***Response to Arguments***

14   Regarding the objection to the drawings under 37 CFR 1.83(a), it has been

15 withdrawn in view of the applicants' remarks in the response filed on 10/27/06.

16   Regarding the objection to the drawings under 37 CFR 1.78(o), it has been

17 withdrawn in view of the replacement sheets submitted by the applicants in the

18 response filed on 10/27/06.

19   Regarding the objection to the specification under 37 CFR 1.75(d)(1), it has been

20 withdrawn in view of the applicants' remarks in the response filed on 10/27/06.

1   Regarding the objection to the summary of the invention under 37 CFR 1.73, it

2   has been withdrawn in view of the applicants' amendment to the specification filed on

3   10/27/06.

4   Regarding the objection to the specification under 37 CFR 1.52(b)(2)(iii), it has

5   been withdrawn in view of the applicants' remarks in the response filed on 10/27/06.

6   Regarding the objection to the specification under 37 CFR 1.52(a)(1)(v), the

7   applicants' arguments have been considered but are not deemed persuasive. The

8   applicants appear to argue that this objection should be withdrawn because the

9   objection was not raised before. While it is regrettable that the objection was not made

10 before, the time at which the objection is raised is alone not sufficient to justify a waiver

11 of the rule. The applicants also argue that there is no proof that the text at issue is not

12 capable of optical character recognition. The examiner sees no reason why actual

13 proof should be required since it is generally known that shading inherently makes the

14 process of optical character recognition more difficult. However, assuming without

15 conceding that proof is required, the examiner attempted to OCR the text at issue and

16 found that it was not recognized by USPTO OCR software that is part of the Image File

17 Wrapper system. Accordingly, the objection is maintained. The applicants are

18 reminded that they may request, under 37 CFR 1.111, that the objection may be held in

19 abeyance until allowable subject matter is indicated.

20   Regarding the rejection to the claims under 35 U.S.C. 101, it has been withdrawn

21 in view of the applicants' amendment to the claims on 10/27/06.

1   Regarding the rejection of claims 1-13, 15-39, and 47-53 under 35 U.S.C. 112

2   first paragraph, the applicants' arguments have been considered but are not deemed

3   persuasive. The applicants appear to be arguing that since the art is predictable, only a

4   single working example must be provided in order to enable the entire scope of the

5   claim. While this may be true in some circumstances, the consideration of whether the

6   entire scope of the claims is enabled is fact specific. In this case, the applicants have

7   ignored the evidence in the record regarding the substantial and fundamental

8   differences between the LonTalk® and BACnet protocols. See the reasons for rejection

9   given above. In a case such as this, where two protocols significantly differ, the

10   applicants were obliged to provide more guidance in their application as originally filed

11   as to how one of ordinary skill in the art would make and use the invention using both

12   protocols. In addition, the applicants argue that incorporation of the present invention in

13   a predictable data transmission protocol would be within the skill of one of ordinary skill

14   in the art. This argument is not persuasive because it is unsupported by any evidence.

15   Regarding the rejection of claims 1-5,8,10-13,15-16, 18-22, 25, 27-34, 36-39,

16   and 47-51 under 35 U.S.C. 102(e) as being anticipated by Hite, the applicants'

17   arguments filed on 10/27/06 have been considered but are not deemed persuasive.

18   The applicants argued that (a) Hite cannot anticipate the claimed invention because it

19   does not teach applications and an application controller that communicate using a

20   proprietary protocol; and (b) Hite cannot anticipate the claimed invention because it

21   does not teach a discover message that inquires as to whether an element

22   corresponding to a system point is stored in a database of an application controller.

1   As to point (a), this argument, although not specifically stated, appears on page

2   22 of the remarks filed on 10/27/06 where the applicants point out that Hite's IA server

3   translates between a web based protocol and a proprietary control network protocol.

4   While HTTP itself is not a proprietary protocol, the applicants' characterization of Hite

5   ignores the fact that the protocol conversion is invoked by calls to a CGI or ASP handler

6   on the IA server (Fig. 4). When invoking a CGI, an HTTP request will have particular

7   parameter information associated with the request (col. 4 lines 20-38). Those

8   parameters are specific to the particular processes implemented on the IA server. Not

9   all web servers would recognize what to do with a request containing those parameters.

10   Accordingly, Hite discloses a system in which proprietary information (i.e., information

11   specific to Hite's application and not generic to all web applications) is transmitted to the

12   IA server. The examiner would point out to the applicants the similarity between this

13   insertion of application specific information into a HTTP request and the applicants'

14   insertion of SP protocol information into the "explicit messages" fields of a LONTalk®

15   message. See specification p. 8 lines 11-16.

16   As to point (b), this argument has been considered but is not deemed

17   persuasive. When a browser in Hite's system access a control area network through a

18   control network portal in order to monitor devices on the control area network, the

19   browser could send a message that would subsequently be translated into a command

20   message on the control area network. This message can discover specific information

21   about a specific operating parameter of a device on a control area network, such as the

22   current ambient temperature measured by a thermostat. The various parameters

1   stored in the control area network devices is a distributed database of information. If

2   the browser requests information about a particular device that is not on the network,

3   Hite's system would generate an error message in response to that request. See Hite

4   Table A indicating Error as a potential response. Since the system would returns valid

5   device information when the device is present and error messages if a device is not, the

6   query from the browser would "discover" whether a whether an element corresponding

7   to a system point is stored in a database, albeit a distributed database, of an application

8   controller.

9   Regarding the rejection of claim 3 under 35 U.S.C. 102(e) as being anticipated

10   by Hite, the applicants' arguments filed on 10/27/06 have been considered but are not

11   deemed persuasive. The applicants argued that (a) Hite does not teach a protocol

12   including a system point identification field for identifying a select system point because

13   (a) a system point corresponds to a variable and a variable is something that changes;

14   (b) a URL only accesses a web page and cannot identify a system point; and (c) a URL

15   cannot be part of a proprietary protocol.

16   As to point (a), this argument is not deemed persuasive in view of Hite's

17   disclosure at col. 3 lines 33-49 that users can monitor things such as current ambient

18   temperature which is inherently a changing value.

19   As to point (b), this argument is not persuasive since Hite teaches that the web

20   pages returned to the user contains information about a variable such as current

21   ambient temperature (col. 3 lines 33-49; col. 4 39-52). Clearly Hite's user is able to

22   specify particular information that is desired base on the fact that the user's request

1   would ultimately be translated into a message on the control area network that is used

2   to obtain specific information from a device, such as current ambient temperature.

3   As to point (c), this argument was addressed above where it was explained how

4   Hite cannot anticipate teaches applications and an application controller that

5   communicate using a proprietary protocol.

6   Regarding the rejection of claim 11 under 35 U.S.C. 102(e) as being anticipated

7   by Hite, the applicants' argued on 10/27/06 that Hite does not teach a message field for

8   determining a format for displaying the element values of a select system point. The

9   persuasiveness of this argument needs to be considered in the context of what the

10   applicants disclose in their specification as field for determining a format for displaying

11   element values. In their specification, the applicants a format field that indicates

12   whether character stings containing the values of elements include formatting

13   information such as the element's units. See specification p. 11 lines 1-10. In view of

14   the remainder of the specification, a message including a measurement such as

15   temperature within a character string can also contain the characters that indicate units

16   of temperature such as F for fahrenheit or C for centigrade. Hite, however, teaches a

17   text based protocol for retrieving parameters such as the current ambient temperature

18   measured by a thermostat. The temperature would be communicated from the

19   thermostat to the master controller via a string of characters. See description of "string"

20   messages in column 22. When a parameter such as a temperature, which in the

21   context of home thermostats, can be measured in a either centigrade or Fahrenheit, a

1   person of ordinary skill in the art would have recognized that the units would be returned

2   with the value.

3   Regarding the rejection of claim 47 under 35 U.S.C. 102(e) as being anticipated

4   by Hite, the applicants' argued, on 10/27/06 that Hite does not teach that a string of a

5   string command is displayed. This argument is in addition to those arguments raised

6   with respect to claim 47 that are identical to those raised with respect to claim 29. This

7   additional argument is not persuasive because it ignores the fact that Hite describes

8   how a measured parameter, such as an ambient temperature, is measured by a device

9   on a control area network and eventually displayed to a user somewhere on the

10   internet. See col. 3 lines 33-49; col. 4 39-52.

11   Regarding the rejection of claim 29 under 35 U.S.C. 102(e) as being anticipated

12   by Hite, the applicants' argued on 10/27/06 that Hite does not teach a message

13   transmitted for cancelling a previous transmitted message. The applicants are referred

14   to columns 34-35 of Hite discussing the cancellation of notification requests.

15

16   *Conclusion*
17
18   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
19   policy as set forth in 37 CFR 1.136(a).
20
21   A shortened statutory period for reply to this final action is set to expire THREE
22   MONTHS from the mailing date of this action. In the event a first reply is filed within
23   TWO MONTHS of the mailing date of this final action and the advisory action is not
24   mailed until after the end of the THREE-MONTH shortened statutory period, then the
25   shortened statutory period will expire on the date the advisory action is mailed, and any
26   extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
27   the advisory action. In no event, however, will the statutory period for reply expire later
28   than SIX MONTHS from the mailing date of this final action.
29

1   Any inquiry concerning this communication or earlier communications from the
2 examiner should be directed to Andrew Caldwell, whose telephone number is (571)
3 272-3868. The examiner can normally be reached on M-Th from 9:00 a.m. to 5:30 p.m.
4 EST.

5

6   The fax number for Group 2100 is as follows:

7

8   Fax Responses: 571-273-8300

9

10   Any general inquiry relating to the status of this application can be answered
11 using Patent Application Information Retrieval (PAIR) system, which is available at the
12 USPTO web site. Any questions on using the PAIR system should be directed to the
13 Patent Electronic Business Center toll free at (866) 217-9197.

14

15 *Andrew Caldwell*

16

17 Andrew Caldwell
18 Supervisory Patent Examiner
19 571-272-3868
20 July 18, 2005

21
22